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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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CLARK & BRODY
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EXAMINER

NGUYEN, MERILYN P

ART UNIT	PAPER NUMBER
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2171

DATE MAILED: 03/10/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,666

Applicant(s)

HERRELL, WILLIAM R.

Examiner

Merilyn P Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Detailed action.

DETAILED ACTION

1. Claims 1-18 are pending in this office action.
2. This application claims priority from provisional patent application no. 60/228,771 filed on August 30, 2000.

Acknowledges

3. Receipt is acknowledged of the following items:
 - o Information Disclosure Statement (IDS) filed on 02/08/2002 and made of record as Paper No. 2. The references cited on the PTOL 1449 form have been considered.

4. **Content of Specification**

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from *two to seven* words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.
- (c) Statement Regarding Federally Sponsored Research and Development: See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc: The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.

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Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.

- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
 - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
 - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.
- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

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- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

The disclosure is objected to because of the following informalities: the title of the invention is too long. Please see the outline above.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 1 recites a system containing method steps instead of structures.

Claims 1, 3, and 15 are being incomplete for omitting essential structural cooperative relationships of elements. The “evaluating performance of an employee” method of the preamble is not described in the body of the claim. The claim body has no limitation reciting how to evaluation performance of an employee.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Shields (US 2002/0032636).

Regarding claim 1, Shields discloses a system (Fig. 1) for evaluating performance of an employee comprising the steps of:

- a. issuing shares in each employee (See paragraph [0009], lines 17-26), and
- b. establishing a market for trading said shares. (See Fig. 9, and [0083, 0084]).

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Regarding claim 2, Shields discloses a searchable database having a profile for each of a number of employees (See paragraphs [0010], [0039], lines 11-21, and [0047], lines 15-32).

Regarding claim 3, Shields discloses a method of evaluating employees of an enterprise comprising:

- a) generating an electronic personal profile for each employee and storing each profile in a database (See paragraphs [0010], [0039], lines 11-21, and [0047], lines 15-32);
- b) issuing a number of shares having a unit value for each employee (See paragraphs [0005], [0049-0050], and [0056]);
- c) establishing a market for buying and selling of the shares wherein employees can only buy or sell shares of other employees (See Figs. 8, 9, and paragraphs [0075]-[0079]); and
- d) identifying at least one job performance trait as part of each buying or selling of shares of each employee (See Figs. 14, 15, and paragraphs [0102, 0103]).

Regarding claim 4, Shields discloses only a select group or employees or owners has access to the at least one job performance trait identified in step (d) (See Figs. 3, and 18).

Regarding claim 5, Shields discloses the buying and selling is performed using a global worldwide network or a specific area network (See paragraph [0041]).

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Regarding claim 6, Shields discloses at least some of the employees update their electronic personal profiles to increase the unit value of their shares (See paragraphs [0054], and Fig. 13).

Regarding claim 7, Shields discloses the unit value is measured in terms of currency, time, an article, or combinations or fractions thereof (See Fig. 7B).

Regarding claim 8, Shields discloses time is the unit value, and the time is one of vacation time, compensatory time, billable time, non-billable time, sick time, maternity time, and combinations and fractions, thereof (See paragraphs [0078, 0087]).

Regarding claim 9, Shields discloses buying or selling of shares is done anonymously (See paragraph [0075]).

Regarding claim 10, Shields discloses the database is searchable to allow employees to search for at least capabilities of other employees (See [0078]).

Regarding claim 11, Shields discloses each employee has a portfolio of shares comprising shares of at least one employee superior, at least one employee peer, and at least one employee subordinate (See Fig. 7B).

Regarding claim 12, Shields discloses at least one employee creating a watch list identifying at least one other employee, the one employee being notified when a profile of the at least one other employee is updated (See [0039], lines 11-21).

Regarding claim 13, Shields discloses a web page accessible for each employee, the web page comprising:

- access to the electronic personal profile of the employee for updating, and monitoring of share performance;
- access to the market for buying and selling of the shares of other employees, and search capability to access at least information in the electronic personal profile of other employees.

See Figs. 14-23.

Regarding claim 14, Shields discloses the web page further comprises access to news provided by the enterprise (148, Fig. 2); access to a help program (System help 132, Fig. 2); access to a frequently asked question program (152, Fig. 2); and access to an indices of data sorted by job function (See [0046]).

Regarding claim 15, Shields discloses a system for evaluating employees of an enterprise comprising:

- a searchable database storing an electronic personal profile of each employee of the enterprise and a number of shares assigned to each employee (See paragraphs [0010], [0039], lines 11-21, and [0047], lines 15-32);
- a market trading system accessible by each employee, the market trading system permitting shares of each employee to be traded by buying or selling when at least one job performance trait associated the employee whose share is being traded is

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identified by the employee requesting the trade (See Figs. 8, 9, and paragraphs [0075]-[0079], and See Figs. 14, 15, and paragraphs [0102, 0103]); and

- a computer allowing each employee access to the searchable database and the market trading system (Finance system 4, Fig. 1).

Regarding claim 16, Shields discloses the computer accesses the searchable database and market trading system through one of a global network and a local area network and a server (See paragraph [0041]).

Regarding claim 17, Shields discloses the market trading system requires each trade to be done without revealing the name of the employee trader (See Fig. 9).

Regarding claim 18, Shields discloses the market trading system generates quotes on shares of the employees based on at least supply and demand for the shares (Quote Server 30, Fig. 1).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marilyn P Nguyen whose telephone number is 703-305-5177. The examiner can normally be reached on M-F: 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-746-7240 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MN ✓
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March 6, 2004


SAFET METJAHIC
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100